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JAN 18 2005

OFFICE OF PETITIONS

In re Application of
Bo Li, et al.
Application No. 10/717,028
Filed: November 18, 2003
Attorney Docket No. 7036566001-3221000

DECISION ON PETITION

This is a decision on the petition filed August 3, 2004, requesting that the above-identified application be accorded a filing date of November 18, 2003.

The application was deposited on November 18, 2003. However, on June 3, 2004, Initial Patent Examination Division mailed a Notice to File Missing Parts of Non-Provisional Application requiring an executed oath or declaration under 37 CFR 1.63, surcharge pursuant to 37 CFR 1.16(e) and replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121. The notice also stated that, while a filing date had been accorded the application papers, a drawing of Figure 9 described in the specification was omitted from the application.

In response, on August 3, 2004, the present petition was filed wherein petitioner argues that 53 pages of drawings and tables were included with the application papers deposited on November 18, 2003. As evidence thereof, petitioner submitted a copy of a postcard showing receipt of "(1) Transmittal (4 pages); (2) Application (Specification 62 pgs; Claims 7 pgs, Drawings 53 pgs; Abstract 1 pg); (4) postcard" on November 18, 2003. Petitioner requests that the application, including a drawing of Figure 9, be accorded a filing date of November 18, 2003. A copy of one sheet of drawing containing Figure 9 was also submitted.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all items listed thereon on the date stamped thereon by the USPTO. See MPEP 503. A review of the postcard receipt reveals that: (1) it was date stamped as received in the Office of Initial Patent Examination (OIPE) on November 18, 2003; (2) it specifically identifies the items being filed, including *inter alia* "Drawings 53 pgs"; and (3) it lacks any annotation of non-receipt of any item denoted on the postcard.

The application papers already considered received in the Office on November 18, 2003, were reviewed along with the missing page of drawing submitted on petition. These papers together constitute the items described on the postcard receipt as "Drawings 53 pgs". Petitioner has shown that a drawing of Figure 9 was among the items present in the application on the date of deposit and should be included in the original disclosure.

Accordingly, the petition is **GRANTED**.

Since the petition was a result of USPTO error, the \$130.00 petition fee is being refunded to counsel's deposit account.

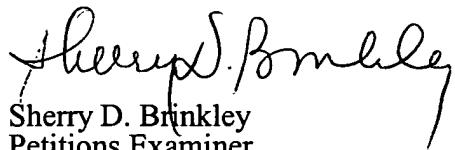
It is noted that a communication entitled "Completion of Filing Requirements..." was filed on October 7, 2004, including a declaration and the \$130 surcharge. However, applicant did not submit the replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121 as required by the notice mailed June 3, 2004.

Further, the declaration filed October 7, 2004 is not in compliance with 37 CFR 1.63 and 1.64. This declaration includes 1 page 1, 5 page 2, and 1 page 4: Each page 2 includes a signature block for joint inventors Li and Kennedy, identified as "Sole or First Inventor" and "Second Joint Inventor", respectively. However, the name in the signature block in the third position on each of the page 2s vary and are either identified as "Sole or First Inventor" and "Second Joint Inventor." Given the format (page numbering, etc.) of the declaration, it is unclear whether all inventors were presented with a declaration in compliance with §§ 1.63 and 1.64, naming all of the actual inventors. Accordingly, it is concluded that the declaration filed October 7, 2004, is not acceptable.

In view of the above, the application is being referred to Initial Patent Examination Division (OIPE) for:

- (1) further processing with a filing date of November 18, 2003, using the application papers filed November 18, 2003 and the one (1) sheet of drawing filed August 3, 2004, and an indication on the bibliographic data sheet that twelve (53) sheets of drawings were included on filing; and
- (2) appropriate consideration of the response filed October 7, 2004.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to OIPE processing should be directed to their hotline at (703) 308-1202.



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